

DETAILED ACTION

1. Claims 1-44 are presently pending. Claim 11—19 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.
2. Claims 1-10, 20-25, and 27-44 are presently pending for examination.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Rejections - 35 USC § 102

4. Claims 1, 2, 4, 6, 10, 20-24, 27-32, and 34-44 remain rejected under 35 U.S.C. 102(b) as being anticipated by Schatz et al (US Patent 6,156,511) (of record 07/03/07), for the reasons of record.
5. Applicant's arguments filed 8/24/09 have been fully considered but they are not persuasive. Applicants traversed the instant rejection on the grounds that the Schatz et al. reference does not teach wherein the disclosed methods encodes a protein having "cis-activity," or further wherein the "encoded protein binds specifically to the DNA molecule from which it is expressed."
6. Contrary to Applicant's assertions, Schatz et al. clearly disclose a method for constructing a random peptide library, wherein said method comprises providing a recombinant DNA vector that encodes a fusion protein that comprises a DNA binding protein and a random peptide, wherein the DNA binding portion of the fusion protein binds to the vector from which it is encoded, see Figure 1. Furthermore, Schatz et al.

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teach methods of making and using a library, wherein the vector includes the DNA domain in which the DNA-binding protein binds to (i.e. encodes a target sequence). The interaction between the DNA binding protein and DNA is non-covalent, and is affect by such parameters as temperature, pH, ionic strength, etc (column 13, lines 45-65). This aspect of the Schatz et al. reference clearly reads on the instant claims to the extent that it teaches wherein the encoded product possesses "cis-activity," and further wherein the encoded product non-covalently binds and/or is non-covalently linked to the DNA from which it is produced.

7. Additionally, Applicants argued that the Schatz et al. does not teach wherein the "DNA constructs are or should be expressed *in vitro*." However, the prior art is interpreted as reading on this aspect of Applicant's invention to the extent that Applicant's definition of the term "*in vitro*" as recited within the context of the claimed method is unclear. If Applicants are attempting to incorporate the concept that the entire method recited in the claims is performed in an "acellular" environment, then the teachings of Schatz et al. which comprises a transformation step into host cells, does not read on the claimed invention. However, if the claimed methods encompass wherein the method is performed in an "*in vitro*" environment, i.e. in culture, then it remains that the Schatz et al. reference reads on the claimed invention. Moreover, to the extent that the method of Schatz et al. comprises wherein the cells transformed with the peptide library are lysed and the fusion protein/DNA vector complexes are isolated and screened by an affinity selection process (see col. 2, lines 39-55), this aspect of

Schatz et al. is interpreted as reading on expressing *in vitro* a plurality of DNA constructs, as recited in claim 1.

Claim Rejections - 35 USC § 103

8. Claims 3, 5, 7, 8, 9 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Schatz et al (US Patent 6,156,511) (of record 07/03/07) as applied to claim 1 above, and further in view of Praszkie et al (Role of CIS in Replication of an IncB Plasmid. Journal of Bacteriology, 1999. 181(9):2765-2772 (listed in applicant's IDS dated 5/27/05).

9. Applicant's arguments filed 08/24/2009 have been fully considered but they are not persuasive. Applicant's allegations have been addressed above, therefore the arguments set forth above in regards to the rejection of claims 1, 2, 4, 6, 10, 20-24, 27-32, and 34-44 under 35 USC 102(b) are incorporated here.

10. Claim 33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Schatz et al (US Patent 6,156,511) (of record 07/03/07) as applied to claim 1 above, and further in view of Edwards et al (US Patent 5,716,780).

11. Applicant's arguments filed 08/24/2009 have been fully considered but they are not persuasive. Applicant's allegations have been addressed above, therefore the arguments set forth above in regards to the rejection of claims 1, 2, 4, 6, 10, 20-24, 27-32, and 34-44 under 35 USC 102(b) are incorporated here.

12. Claim 25 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Schatz et al (US Patent 6,156,511) (of record 07/03/07) as applied to claim 1 above, and Szostak et al (US Patent 6,281,344) further in view of Mattheakis et al (An *in vitro*

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polysome display system for identifying ligands from very large peptide libraries. PNAS, 1994.91:9022-9026) (listed in applicant's IDS dated 05/27/05).

13. Applicant's arguments filed 08/24/2009 have been fully considered but they are not persuasive. Applicants allegations have been addressed above, therefore the arguments set forth above in regards to the rejection of claims 1, 2, 4, 6, 10, 20-24, 27-32, and 34-44 under 35 USC 102(b) are incorporated here.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Smith whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 10:00 AM through 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Janet L. Epps-Smith/
Primary Examiner, Art Unit 1633